

Remarks

In the Advisory action, the previous rejection was maintained. Reconsideration of this rejection is warranted. The sole issue is whether the applicants' claims were rendered obvious by a combination of references.

No Proper Teaching to Combine is Cited

The obviousness rejections should be withdrawn because there is no proper teaching for the combination of the cited references. "Our case law makes clear that the best defense against the subtle but powerful attraction of a hindsight based obviousness analysis is a rigorous application of the requirement for a showing of the teaching or motivation to combine the prior art references." In re Dembiczak, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999) (internal citations omitted). "The showing must be clear and particular. Broad conclusory statements regarding the teaching of multiple references, standing alone, are not 'evidence'." The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. In re Mills, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990). If proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. In re Gordon, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984).

As noted in the previous remarks, the two cited references cannot be properly combined. One reference, the '031 patent, discloses an electrophoresis device with a loader for dispensing relatively small amounts of sample into relatively small ports. In contrast, the '670 patent discloses a device for assembling ELISA-type assays using much larger amounts of reagents dispensed into macroscale device.

The sole cited motivation for combining these disparate references was conclusory conjecture, not specific teachings within the cited references which would lead to the instant combination.

In the Advisory action, again no specific teaching in the reference is cited for the combination. Instead, it is merely noted that some of the features which make the two cited references incompatible for combination are not claimed by the applicants. However this is not relevant. If two references lack a teaching to combine, this alone is sufficient to obviate the rejection.

The Asserted References do not Render Obvious
the Applicants' Claims

Even if the references are combined, this combination does not render obvious the applicants' claims.

An obviousness finding requires determining the scope and content of the prior art and ascertaining the differences between the cited art and the claims at issue. See *Graham v. John Deere Co.*, 148 USPQ 459 (S.C. 1966). When applying 35 USC Section 103 in a finding of obviousness, the tenants of patent law require that the claimed invention be considered as a whole, that the cited references must suggest the desirability and thus the obviousness of making the claimed combination, that the cited references must be viewed without the benefit of impermissible hindsight afforded by the claimed invention, and that the cited reference provide a reasonable expectation of success in practicing the claimed technology. See *Hodosh v. Block Drug Co., Inc.*, 229 USPQ 182, 187 (Fed. Cir. 1986).

Claim 1, as presently submitted, specifies both that the multifunctional device may be aligned with the ports of the substrate and that the multifunctional device allows transfer of a plurality of samples. In addition, as previously noted, the multifunctional device was defined in the specification. This definition is now explicitly reflected in claim 1 and include ganged pipettors and a vacuum line. These features are not found in the cited art.

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Respectfully submitted,

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